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BANNER & WITCOFF , LTD
ATTORNEYS FOR CLIENT NUMBER 007412
1100 13th STREET, N.W.
SUITE 1200
WASHINGTON, DC 20005-4051

EXAMINER	
DAYE, CHELCIE L	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL L. ASMUSSEN, JOHN S. MCCOSKEY,
and WILLIAM D. SWART

Appeal 2009-002471
Application 09/921,057
Technology Center 2100

Decided: November 2, 2009

Before LANCE LEONARD BARRY, JEAN R. HOMERE, and
JOHN A. JEFFERY, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 1-11 and 21-33. Claims 12-20 have been withdrawn from consideration. *See* App. Br. 5; Ans. 2. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

Appellants invented a device that constructs a suggestion database 308 of metadata elements or words using a content metadata crawler 309. A search suggestion engine 304 then uses indexed metadata to produce suggestion lists from the available content based on search request criteria.[1]

Independent claim 1 is reproduced below with the key disputed limitations emphasized:

1. An apparatus for suggesting available aggregated content from a plurality of media sources in a digital communications network, comprising:

a content metadata crawler that searches metadata related to the available aggregated content from the plurality of media sources and produces a metadata list, wherein the metadata list comprises a plurality of metadata elements, and wherein each metadata element comprises one or more metadata fields;

a suggestion keyword indexer coupled to the content metadata crawler, wherein the suggestion keyword indexer receives the metadata list and indexes the metadata elements;

a suggestion database coupled to the suggestion keyword indexer that stores the indexed metadata elements; and

a suggestion database processor coupled to the content metadata crawler, the suggestion keyword indexer and the suggestion keyword database, *wherein the suggestion database processor searches the suggestion database, based on one or more search request criteria, to produce a list of keywords to be used to suggest content* from the plurality of media sources.

[1] *See generally* Spec. 14-17, 19, and 20; Figs. 6a and 6b.

The Examiner relies on the following prior art references to show unpatentability:

Balogh	US 5,493,677	Feb. 20, 1996
Karaali	US 6,182,028 B1	Jan. 30, 2001
Cappi	US 2002/0038308 A1	Mar. 28, 2002
Dudkiewicz	US 6,651,253 B2	Nov. 18, 2003 (filed Nov. 16, 2001)[2]

The Examiner's rejections are as follows:

(1) Claims 1 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Balogh and Dudkiewicz. Ans. 4-5

(2) Claims 2, 3, 5-11, 22, 23, and 26-33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Balogh, Dudkiewicz, and Cappi. Ans. 5-9.

(3) Claims 4, 24, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Balogh, Dudkiewicz, Cappi, and Karaali. Ans. 10-11.

Rather than repeat the arguments of Appellants or the Examiner, we refer to the Brief and the Answer[3] for their respective details. In this decision, we have considered only those arguments actually made by

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[2] This patent claims the benefit under § 119(e) of Provisional Application No. 60/239,179, filed November 16, 2000. This patent also claims the benefit under § 120 of Patent Application Nos. 09/793,294; 09/793,322; 09/793,357; and 09/793,479, each filed on Feb. 26, 2001.

[3] Throughout this opinion, we refer to: (1) the Appeal Brief filed June 28, 2007 and (2) the Examiner's Answer mailed September 27, 2007.

Appellants. Arguments which Appellants could have made but did not make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

OBVIOUSNESS REJECTION OF BALOGH AND DUDKIEWICZ

We group the claims as follows: (1) claim 1 and (2) claim 21. We will address each grouping separately.

Claim 1

Regarding independent claim 1, the Examiner finds Balogh discloses all the limitations, except for: (1) the content being aggregated from the plurality of media sources and (2) the suggestion database processor searching the suggestion database based on one or more search request criteria to produce a list of keywords to be used to suggests content form the plurality of media sources. Ans. 4-5. The Examiner relies on Dudkiewicz to teach these missing limitations. Ans. 5. Appellants argue that Dudkiewicz does not qualify as prior art since Provisional Application No. 60/249,179, for which Dudkiewicz claims priority, does not support the discussion of the metadata generator providing automatic generation of keywords. Br. 10-13.

ISSUE

The following issue has been raised in the present appeal:

Have Appellants shown that the Examiner erred in rejecting claim 1 under § 103 by finding that Dudkiewicz qualifies as prior art under 35 U.S.C. § 102(e)?

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

Appellants' Disclosure

(1) The present application was filed on August 3, 2001. Appellants also admit that the effective filing date of the present application is August 3, 2001. Br. 10.

(2) The Specification states that "[s]earch criteria can be entered using keywords that relate to certain aspects of programming content including, but not limited to, subject, author, title, cast members or performers, director, and/or content description . . . . An example might be the entry of "Titanic" as a keyword." Spec. 19:12-15 and 23-24

Dudkiewicz

(3) Dudkiewicz has a filing date of November 16, 2001.

(4) Dudkiewicz claims priority to Provisional Application No. 60/249,179, filed November 16, 2000.

(5) Dudkiewicz teaches using a metadata generator 18 to receive program descriptive data (PDD) and provide automatic generation of titles for programming events. The metadata generator 18 distributes programming events metadata to a client device (e.g., 26) and programming instructions that process metadata for determining programming events desirable for viewing and storage according to a view profile. Col. 7, ll. 22-34, col. 12, ll. 55-57, col. 13, ll. 30-32, and col. 14, ll. 39-59; Fig. 1.

(6) The client device provides tools, such as a program grid and keyword searching, so the user can manually identify programs for viewing or recording. Col. 15, ll. 33-43.

(7) Dudkiewicz teaches the client device has programming instructions for providing an editor and graphical user interface with tools enabling the user to create a viewer profile tailored to the user's viewing taste. The user profile includes a Keyword_List containing keywords reflecting a user's viewing taste. For example, the keyword "Bills" is associated with the category Sports/Football/NFL is selected. The client device may also determine the preferred programming events based on a user's profile. Col. 15, ll. 46-48, col. 16, ll. 6-14 and 25-33, and col. 19, ll. 30-42.

Underlying Provisional Application 60/239,179

(8) Provisional Application No. 60/249,179 ("the Provisional Application") explains the invention contains software that allows the user to search an imported EPG "for programs using the following criteria: date, program name, keywords." Any program that matches the search criteria will be displayed. Pp. 24 (cEPG005) and 26 (cCOMP004).

(9) The Provisional Application explains that the user selects a user profile (e.g., "sports freak"). Based on the selection, appropriate categories are automatically chosen. Pp. 15 and 24 (cUP001-cUP002).

PRINCIPLES OF LAW

During examination of a patent application, a claim is given its broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (internal citations and quotations omitted).

Section 102 of the Patent Act states:

A person shall be entitled to a patent unless —

. . .

(e) the invention was described in — . . . (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for paten . . . .

Section 111(b) of the Patent Act states:

(8) APPLICABLE PROVISIONS. —The provisions of this title relating to applications for patent shall apply to provisional applications for patent, except as otherwise provided, and except that provisional applications for patent shall not be subject to sections 115, 131, 135, and 157 of this title.

A U.S. provisional application is considered an "application for patent" within the meaning of § 102(e). *Ex parte Yamaguchi*, 88 USPQ2d 1606, 1609 (BPAI 2008) (precedential).

Additionally, 35 U.S.C. § 119(e) states:

(1) An application for patent filed under section 111(a) . . . of this title for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed under section 111(b) of this title, by an inventor or inventors named in the provisional application, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b) of this title . . . .

ANALYSIS

The pivotal issue in this case is whether Dudkiewicz qualifies as prior art under § 102(e). Integral to this analysis is a determination of Dudkiewicz's critical reference date. The 35 U.S.C. § 102(e) critical reference date of a patent entitled to the benefit of the filing date of a provisional application under 35 U.S.C. § 119(e) is the filing date of the provisional application if the provisional application properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. § 112, first paragraph. *See* 35 U.S.C. §§ 102(e) and 119(e); *see also Yamaguchi*, 88 USPQ2d at 1609. Thus, Dudkiewicz's qualification as prior art hinges on whether the Provisional Application reasonably supports the subject matter in Dudkiewicz under 35 U.S.C. § 112, first paragraph that was relied upon in the Examiner's obviousness rejection of claim 1.

Claim limitations are given their broadest reasonable construction in light of the Specification. *See Am. Acad.*, 367 F.3d at 1364. The Specification states that "search criteria can be entered using keywords that relate to certain aspects of programming content including, but not limited to, subject, author, title, cast members or performers, director, and/or content description . . . . An example might be the entry of 'Titanic' as a keyword." FF 2. Thus, in light of the Specification, the recited keywords in claim 1 can include a program title or subject. *See id.* Also, notably and contrary to Appellants assertions (Br. 12), there is no recitation to an "automatic generation of keywords." With this understanding in mind, we next

determine whether Dudkiewicz teaches that "the suggestion database processor searches the suggestion database, based on one or more search request criteria, to produce a list of keywords to be used to suggest content" recited in claim 1.

Dudkiewicz teaches using a metadata generator that distributes PDD or program titles to a client device. FF 5. The client device or processor has tools, including a program grid and a keyword searching tool, to allow the user to identify programs for viewing. FF 6. Thus, Dudkiewicz teaches a client device or processor that allows the user to search a database using a search criteria (e.g., entering a keyword in the searching tool) and displays programming events or a list for viewing on a program grid. As the lists will include titles for programming events (*see* FF 5), Dudkiewicz's processor also produces a list of keywords to be used to suggest content based on a search request criteria as recited in claim 1.

An equivalent description of these features in Dudkiewicz is found in the Provisional Application. The Provisional Application describes software that allows the user to search the imported EPG "for programs using the following criteria: date, program title, keywords." FF 8. This portion of the Provisional Application reasonably corresponds to Dudkiewicz's discussion of using a metadata generator to distribute PDD (i.e., the imported EPG) and using the client's device keyword searching tool. The Provisional Application also indicates that any program that matches the criteria will be displayed. *Id.* This portion of the Provisional Application reasonably

corresponds to Dudkiewicz's discussion of using a program grid to allow users to identify programs. Moreover, as Appellants acknowledge (Br. 12), the Provisional Application does not have "to explicitly repeat word for word" what is taught in Dudkiewicz.

Thus, the above-discussed descriptions in Dudkiewicz find support under 35 USC § 112, first paragraph in Provisional Application No. 60/249,179. For purposes of the above discussed portions, Dudkiewicz: (1) is entitled to the benefit of the provisional application's filing date of November 16, 2000 (FF 4); (2) has a critical reference date (November 16, 2000) that predates Appellants effective filing date of August 3, 2001 (FF 1); and (3) qualifies as prior art under § 102(e).

Additionally, Dudkiewicz teaches that the client device or processor has programming instructions for providing an editor and a graphical user interface enabling the user to create a viewer profile tailored to the user's viewing taste. FF 7. The client device also determines the preferred programming events based on a user's profile. *Id.* For example, the keyword "Bills" is associated with the category Sports/Football/NFL. *Id.* Based on the keywords in the viewer profile, a list of other subjects or keywords is generated and stored in the Keyword_List portion of the user profile. *See id.* Thus, giving this limitation its broadest reasonable construction, this portion of Dudkiewicz also teaches a processor that searches a database based on a viewer profile or search criteria to produce a list of keywords (e.g., categories) to be used to suggest content based on a search request criteria as recited in claim 1. *See Am. Acad.*, 367 F.3d at 1364.

An equivalent description of these features in Dudkiewicz is found in the Provisional Application that describes that the user selects a user profile (e.g., "sports freak") and appropriate categories are chosen. FF 9. This discussion reasonably corresponds to Dudkiewicz's explanation of a client device with an editor that enables the user to create a user profile and then generate categories or a list of keywords used to suggest content. Thus, the above-discussed descriptions in Dudkiewicz find support under § 112, first paragraph in the Provisional Application. Again, for purposes of the above discussed portions, Dudkiewicz: (1) is entitled to the benefit of the provisional application's filing date of November 16, 2000 (FF 4); (2) has a critical reference date (November 16, 2000) that predates Appellants' effective filing date of August 3, 2001 (FF 1); and (3) therefore qualifies as prior art under § 102(e).

For the above reasons, Appellants fail to show that Dudkiewicz does not qualify as prior art. Accordingly, we sustain the rejection of independent claim 1 based on that reference.

Claim 21

Independent claim 21 is broader in scope than claim 1. Claim 21 recites "based on the one or more search request criteria, to produce a list of metadata elements" rather than a list of keywords. The keywords discussed above are also metadata elements originated form the PDD. *See* FF 5. Thus, for similar reasons, we are not persuaded by Appellants' argument that Dudkiewicz fails to qualify as prior art under § 102(e).

OBVIOUSNESS REJECTION OF BALOGH, DUDKIEWICZ, AND CAPPI

Claims 2, 3, 5-11, 22, 23, and 26-33

Appellants do not separately argue dependent claims 2, 3, 5-11, 22, 23, and 26-33 but rely on the discussion of independent claims 1 and 21. *See* Br. 13-14. We are not persuaded by Appellants' argument for the reasons disclosed above with regard to Dudkiewicz, the Provisional Application, and claims 1 and 21. Accordingly, we sustain the rejection of claims 2, 3, 5-11, 22, 23, and 26-33.

OBVIOUSNESS REJECTION OF BALOGH, DUDKIEWICZ, CAPPI, AND KARAALI

Claims 4, 24, and 25

Appellants do not separately argue dependent claims 4, 24, and 25 but rely on the discussion of independent claims 1 and 21. *See* Br. 14. We are not persuaded by Appellants' argument for the reasons disclosed above with regard to Dudkiewicz, the Provisional Application, and claims 1 and 21. Accordingly, we sustain the rejection of claims 4, 24, and 25.

CONCLUSIONS

Appellants have not shown that the Examiner erred in rejecting claims 1-11 and 21-33 under § 103 by finding that Dudkiewicz qualifies as prior art under 35 U.S.C. § 102(e).

DECISION

We have sustained the Examiner's rejection with respect to all claims on appeal. Therefore, we affirm the decision of the Examiner to reject claims 1-11 and 21-33.

No period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

pgc

BANNER & WITCOFF , LTD
ATTORNEYS FOR CLIENT NUMBER 007412
1100 13th STREET, N.W.
SUITE 1200
WASHINGTON DC 20005-4051